

**Remarks**

This Amendment is in response to the Office Action dated **November 14, 2007**, wherein claims 12, 24, 36 and 37 were rejected under 35 U.S.C. §112, second paragraph; claims 1-7, 25-32 and 40 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,735,871 to Sgro (Sgro ‘871); claims 1-7, 26, 28, 30, 32, and 38-39 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,496,365 to Sgro (Sgro ‘365); claims 8-11, 13-15 and 34-37 were rejected under 35 U.S.C. §103(a) as being obvious over Sgro ‘365 in view of U.S. 6,165,178 to Bashiri et al. (Bashiri); claim 12 was rejected under 35 U.S.C. §103(a) as being obvious over Sgro ‘365 in view of Bashiri, as applied to claims 8 and 11, and further in view of U.S. 6,699,280 to Camrud et al. (Camrud); claims 16-19, 44 and 45 were rejected over Sgro ‘365 in view of Bashiri, as applied to claim 15, and further in view of U.S. 5,702,418 to Ravenscroft; and claim 21-24 and 33 were rejected under 35 U.S.C. §103(a) as being obvious over Sgro ‘365 in view of U.S. 6,355,058 to Pacetti et al (Pacetti).

The following comments are presented in the same order and with section headings and paragraph numbers corresponding to the Office Action.

**Elections/Restrictions**

1. Applicants acknowledge to withdrawal of claims 41-43. The claims have been designated as “withdrawn”.

**Double Patenting**

2. In an effort to facilitate prosecution, Applicants have cancelled claim 25 without prejudice or disclaimer.

**Claim Rejections – 35 USC §112**

3-6. In the Office Action claims 12, 24, 36 and 37 were rejected under §112 as being indefinite. More specifically, in paragraph 5 of the Office Action, the claim term “the severable junction” presented in claim 12 was said to have insufficient antecedent basis; and in paragraph 6 of the Office Action, the claim term “the push wire” presented in claims 24 and 36 was said to have insufficient antecedent basis.

In response, Applicants recognize that claim 12 improperly depended from claim 8. This typographical error has been corrected and instant claim 12 has been amended to depend from claim 11. In regard to claim 24, Applicants assume that the rejection of claim 24 was the result of a typographical error in the Office Action and that the rejection was intended to be directed to claim 34. As to claims 34 and 36, the instant claims have been amended to depend from claim 8. Claim 37 depends from claim 36.

In light of the above amendments, withdrawal of the §112 rejections is requested.

### **Claim Rejections – 35 USC §102**

**7-8.** In the Office Action claims 1-7, 25-32 and 40 were rejected under §102(b) as being anticipated by Sgro ‘871.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” (*Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Though claim 1 is presented in its entirety above, aspects of the claim relevant to the current rejection include the recitation that the stent comprise a first stent backbone oriented in a direction which is substantially parallel to a longitudinal axis of the stent, and a plurality of interconnected second stent members oriented in a substantially longitudinal direction in the unexpanded state and being oriented in a substantially circumferential direction in the expanded state. In addition, claim 1 states that the first stent backbone has a greater column strength than the plurality of interconnected stent members.

The Sgro ‘871 fails to teach or suggest any of these features.

The assertion in the Office Action that the transverse strands (7) depicted in Sgro are oriented in a substantially longitudinal direction in an unexpanded state is simply not supported by the disclosure of Sgro ‘871. While Sgro ‘871 does describe an endoprosthesis having a deployed state and an unexpanded state or “folded-down configuration” (column 3, line 66 – column 4, line 5) nowhere however, does Sgro ‘871 depict, describe or even imply that the transverse strands (7) of the endoprosthesis are oriented in a substantially longitudinal direction in such an unexpanded state as the instant claims describe.

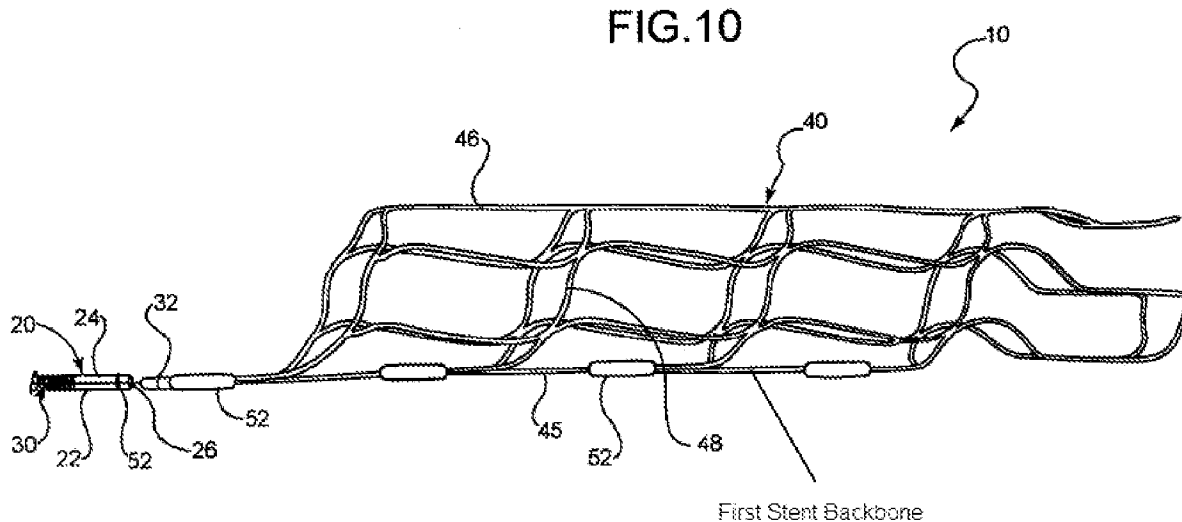
Without at least some depiction and/or description of the Sgro ‘871 endoprosthesis in the unexpanded state it is impossible for one of ordinary skill in the art to determine the manner or extent of the orientation of Sgro’s transverse strands (7) in the “folded-down configuration”. As a result, Sgro ‘871 cannot be said to anticipate claim 1 or any claim dependent therefrom.

Despite the above, if it is pretended for the sake of argument that Sgro ‘871 does in fact disclose a stent in an unexpanded state having the orientation characteristics described in claim 1, Sgro ‘871 will still nevertheless fail to anticipate the instant claims. In the Office Action it is asserted that the “first stent backbone” of Sgro ‘871 has “greater column strength than the plurality of interconnected stent members” as the instant claims describe. This is simply not the case.

First, in direct contrast to the requirements of the instant claims, Sgro ‘871 fails to teach, suggest or provide any mention of “column strength” in regard to any of the various elements of the Sgro endoprostheses. In light of this failure, it appears that the Office Action seeks to impose a definition of “first stent backbone” that would presumably meet the comparative strength recitation of the instant claims. The definition the Office Action seeks to impose upon the term “first stent backbone” is however, contrary to the teachings of the present application and beyond that which one of ordinary skill in the art would utilize. Such imposition of external and abstract definitions on clearly supported and understandable claim terms is improper.

The instant claims, and the supporting disclosure provided by the application as filed, provide clear meaning and understanding of the claimed phrase “first stent back bone” that one of ordinary skill in the art would recognize. The Federal Circuit has time and time again made it clear that it is the inventor’s own lexicography that governs the meaning of claimed terms and that it is the specification which is the best guide for determining the meaning of claim terms. See *Phillips v. AWH Corporation*, 75 USPQ2d 1321 (Fed. Cir. 2005). See also *Ferguson Beauregard/Logic Controls v. Mega Sys., LLC*, 350 F.3d 1327, 1338 (Fed. Cir. 2003). See also *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473,1477 (Fed. Cir. 1998).

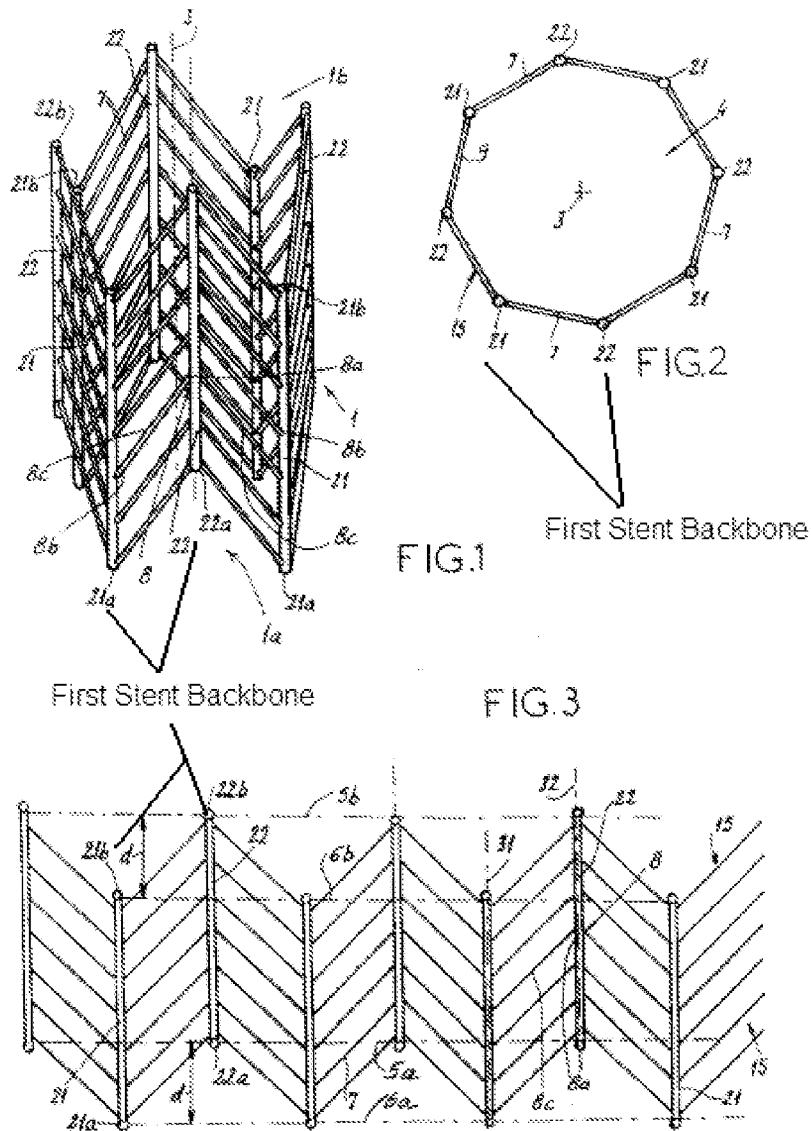
With this standard in mind, an exemplary embodiment of the present invention is depicted as follows in an annotated copy of FIG. 10 wherein the “first stent backbone” 45 is clearly labeled.



As shown above, and as made explicitly clear in the specification, stent 40 comprises a backbone 45 and a plurality of first and second stent members or struts 46 and 48. (Page 7, lines 21-22). The first stent backbone clearly does NOT include elements 48 and does NOT include additional longitudinal elements as well. See also page 8, lines 3-25 for a discussion of the relative structural positions and movements of the various stent elements relative to the first stent backbone 45 during expansion.

In contrast to the definition provided by the present Application, the Office Action contends that the “first stent backbone” of Sgro ‘871 should somehow be interpreted to include “element 21 and 22 which are adjacent” and the “connecting members 7 between them”.

The Office Actions definition of a “first stent backbone” is illustrated in the following annotated figures of Sgro ‘871 by the entire region of the endoprosthesis shown between the added lead lines.



No one of ordinary skill in the art could reasonably conclude that the “first stent backbone”, which the Office Action asserts Sgro ‘871 to disclose, is in anyway within the definition of “the first stent backbone” described in the present claims.

Because Sgro ‘871 does not teach or suggest a “first stent backbone” as the present claims describe, and because Sgro ‘871 provides no comparative information regarding column strength between the various elements of its endoprosthesis it is impossible to assert that Sgro ‘871 anticipates the instant claims which state: “the first stent backbone having a greater column strength than the plurality of interconnected stent members.” As a result, the rejection is traversed.

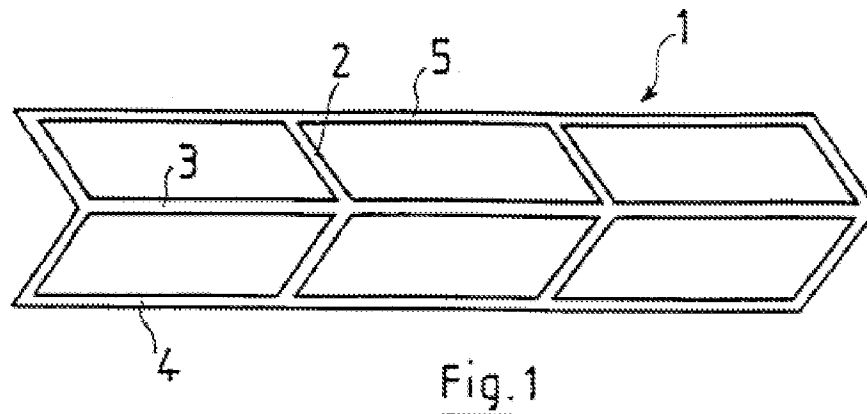
**9-14.** Instant claim 1 is an independent claim. Claims 2-7, 25-32 and 40 depend directly or indirectly from claim 1. For at least the reasons stated above in regard to claim 1, the rejections to the dependent claims are respectfully traversed.

**15.** In the Office Action claims 1-7, 26, 28, 30, 32 and 38-39 were rejected under §102 as being anticipated by Sgro '365.

In the Sgro '365 reference the Office Action makes many of the same assertions against the instant claims using characteristics of the Sgro '365 reference that are similar in scope and meaning to the characteristics of the Sgro '871 reference. Thus, for the same reasons that Sgro '871 fails to anticipate the instant claims so to does Sgro '365 fail.

In contrast to the assertion in the Office Action, nowhere does Sgro '365 disclose that the transverse strands (2) are oriented in a substantially longitudinal direction in an unexpanded state as the instant claims recite.

As to the Office Action's assertion that the "first stent backbone" of Sgro '365 has greater column strength than the plurality of interconnected stent members, this assertion is based on the Office Action's improper imposition of an abstract definition of the claimed term "first stent backbone". Like Sgro '871, Sgro '365 fails to provide any mention of "column strength" or similar characteristics for any of the various structural features of its endoprosthesis. In order to overcome this failure, the Office Action imposes a definition of the "first stent backbone" to Sgro '365 that presumably meets the comparative strength recitation of the instant claims. The definition of the "first stent backbone" that the Office Action imposes upon Sgro '871 includes multiple longitudinal ribs (adjacent elements 3 and 4 as shown below).



In contrast, the present application provides for a “first stent backbone” that is clearly defined and does not include additional longitudinal structures and stent members therebetween (see discussion and copy of FIG. 10 above). Because Sgro ‘365 fails to disclose a “first stent backbone” within the meaning provide by the present application, and because Sgro ‘365 provides no comparative information regarding column strength between the various elements of its endoprosthesis it is impossible to assert that Sgro ‘365 discloses a “first stent backbone having a greater column strength than the plurality of interconnected stent members” as the instant claims describe.

For at least the reasons discussed above the §102 rejection based on Sgro ‘365 is traversed.

**16-21.** Instant claim 1 is an independent claim. Claims 2-7, 26, 28, 30-32, 38 and 39 depend directly or indirectly from claim 1. For at least the reasons stated above in regard to claim 1, the rejections to the dependent claims are traversed.

### **Claim Rejections – 35 USC §103**

**22-26.** In the Office Action claims 8-11, 13-15 and 34-37 were rejected under §103(a) as being obvious over Sgro ‘365 and Bashiri. More specifically, the Office Action asserts that it would be obvious to add the wire of Bashiri to the teachings of Sgro ‘365 in order to provide for a hybrid device supposedly having all of the elements described in the instant claims.

Claims 8-11, 13-15 and 34-37 are all claims that depend directly or indirectly from independent claim 1. The failure of Sgro ‘365 to teach or suggest all of the elements of the instant claims has been discussed above. The addition of Bashiri’s wire does nothing to address the failure. Therefore, assuming *arguendo* that motivation exists to combine the wire of Bashiri with the endorprosthesis of Sgro ‘365 in the manner proposed in the Office Action, the resulting hybrid will still fail to teach or suggest all of the elements of the instant claims. As a result, the rejection is traversed.

**27-28.** In the Office Action claim 12 was rejected under §103(a) as being obvious over Sgro ‘365 in view of Bashiri, as applied to claims 8 and 11, and further in view of Camrud.

More specifically, the Office Action asserts that it would be obvious to add the wire of Bashiri to the teachings of Sgro '365 and that it would also be obvious to further modify the Sgro '365/Bashiri hybrid by providing the junction between the stent and push wire with a bioabsorbable connection as described in Camrud.

Applicants note that claim 12 depends from claim 1 (via claims 11 and 8). The failure of Sgro '365 to teach or suggest all of the elements of the instant claims has been addressed above. Regardless of any motivation to combine the references cited in the Office Action, the proposed addition of Bashiri's wire does nothing to address this failure, and likewise the proposed addition of Camrud's bioabsorbable connection does nothing to address this failure. The references, whether viewed alone or in combination simply fail to teach or suggest all of the elements of the instant claims. As a result the rejection is traversed.

**29-32.** In the Office Action claims 16-19, 44 and 45 were rejected under §103(a) as being obvious over Sgro '365 in view of Bashiri, as applied to claim 15, and further in view of Ravenscroft. More specifically, the Office Action asserts that it would be obvious to further modify the Sgro '365/Bashiri hybrid by providing it with the capability of a stent delivery system wherein the stent can transition from a deployed configuration to a predeployed configuration as described in Ravenscroft.

Claims 16-19, 44 and 45 are dependent claims that directly or indirectly depend from claim 1. The failure of Sgro '365, with or without Bashiri, to teach or suggest all of the elements of the instant claims is detailed above. Providing the Sgro endoprosthesis with the capability to transition from an initially deployed state to a predeployed state as provided for in Ravenscroft will do nothing to address the failure of Sgro '365 by itself or in combination with other references to render the instant claims obvious. As a result, the rejection is traversed.

**33-34.** In the Office Action claims 21-24 and 33 were rejected under §103(a) as being obvious over Sgro '365 and Pacetti. More specifically, the Office Action asserts that it would be obvious to construct the Sgro '365 endoprosthesis from nitinol wire as described in Pacetti in order to provide for a hybrid device supposedly having all of the elements of the instant claims.

Claims 21-24 and 33 are all claims that depend directly or indirectly from



independent claim 1. The failure of Sgro '365 to teach or suggest all of the elements of the instant claims has been discussed above. The addition of any given material as described by Pacetti to make the Sgro '365 endoprosthesis does nothing to address the basic failure of Sgro '365 to teach or suggest all of the elements of the instant claims. Thus, even if one were to assume that motivation exists to combine the nitinol wire of Pacetti with the endoprosthesis of Sgro '365 in the manner proposed in the Office Action, the resulting hybrid will still fail to teach or suggest all of the elements of the instant claims. As a result, the rejection is traversed.

### **Conclusion**

Based on at least the foregoing amendments and remarks, Applicant respectfully submits this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-24, 26-40 44 and 45 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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